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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,645	11/14/2003	David A. Evans	940630-010022	1642

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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,645

Applicant(s)

EVANS ET AL.

Examiner

Etienne P. LeRoux

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2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Status:

Claims 1-27 are pending. Claims 1-27 are rejected as detailed below.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 provides for the use of a process of identification, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 1 recites:

(1) identifying a second set of documents and a remainder set of documents from said training set of documents **using** (emphasis added) said first profile

(2) creating a first sub-filter **using** (emphasis added) said first profile

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(3) creating at least one remainder sub-filter **using** (emphasis added) at least one of said remainder

Claim 1 recites "identifying at least one remainder profile corresponding to each of said identified sets of documents from said remainder set of documents." The specification does not include a single instance of "remainder profile."

Claim 1 recites "creating a first sub-filter using a first profile." The specification does not include a single instance of "first sub-filter."

Claims 10 and 19 are rejected on the same basis as claim 1.

Claims 2-9, 11-18 and 20-27 are rejected for at least being dependent from a rejected base claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites in the preamble "A process for creating an ensemble filter for selecting documents" and in the body of the claim recites "combining said first sub-filter with at least one remainder sub-filter to create an ensemble filter." The scope of the invention cannot be determined because it is unclear how many ensemble filters applicant is claiming.

Claim 1 recites the following documents:

(1) a set of documents for training

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- (2) a first set of documents identified from the training set
- (3) a second set of documents identified from the training set
- (4) a remainder set of documents identified from the training set
- (5) a set of documents identified from the remainder set of documents

The scope of the invention cannot be determined because the difference, if any, between above plurality of sets of documents is difficult to determine. For purposes of this Office action, examiner will assume that it would have been obvious to one of ordinary skill in the art at the time the invention was made to select one or more sets of documents from the training set of documents.

Claims 10 and 19 are rejected on the same basis as claim 1.

Claims 2-9, 11-18 and 20-27 are rejected for at least being dependent from a rejected base claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-27 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Pub No US 2004/0039786 issued to Horvitz et al (hereafter Horvitz), as best examiner is able to ascertain.

Claims 1, 10 and 19:

Horvitz discloses:

identifying a set of documents for training [Fig 11, paragraphs 54, 122];

identifying a first coherent set of documents from said training set of documents
[paragraph 55]

identifying a first profile corresponding to said first coherent set of documents [paragraph 148]

identifying a second coherent set of documents and a remainder set of documents from said training set of documents using said first profile [paragraph 54, 148]

identifying at least one coherent set of documents from said remainder set of documents
[paragraph 55]

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identifying at least one remainder profile corresponding to each of said identified coherent sets of documents from said remainder set of documents [paragraph 55]

creating a first sub-filter using said first profile [Figs 3, 6]

creating at least one remainder sub-filter using at least one of said remainder profiles [Figs 3, 6]

combining said first sub-filter with at least one remainder sub-filter to create an ensemble filter [paragraphs 12, 29, 32, 33, 40, 45 Figs 1, 3, 6]

Claims 2, 11 and 20:

Horvitz discloses clustering said training set of documents to identify said first coherent set of documents [paragraph 10]

Claims 3, 12 and 21:

Horvitz discloses further comprising: clustering said training set of documents and selecting said largest cluster to identify said first coherent set of documents [paragraph 34]

Claims 4, 13 and 22:

Horvitz discloses cascading said first sub-filter and at least one remainder sub-filter to create at least part of said ensemble filter [abstract].

Claims 5, 14 and 23:

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Horvitz discloses mutiplexing said first sub-filter with at least one remainder sub-filter to create at least part of said ensemble filter [paragraph 32]

Claims 6, 15 and 24:

Horvitz discloses cascading said first sub-filter and at least one remainder sub-filter to create at least part of said ensemble filter [paragraph 32]

Claims 7, 16 and 25:

Horvitz discloses cascading said first sub-filter and at least one remainder sub-filter to create at least part of said ensemble filter [Fig 3, paragraph 12].

Claims 8, 17 and 26:

Horvitz discloses mutiplexing said first sub-filter with at least one remainder sub-filter to create at least part of said ensemble filter [Fig 3, paragraph 12]

Claims 9, 18 and 27:

Horvitz discloses mutiplexing said first sub-filter with at least one remainder sub-filter to create at least part of said ensemble filter [Fig 3, paragraph 12]

Response to Arguments

Applicant's arguments filed 7/17/2006 have been fully considered but they are not persuasive.

Applicant states on page 8 “identifying at least one set of documents from said remainder set of documents” refers to inter alia, the set of documents 1226 illustrated in Figures 12b-12c and discussed in the corresponding portion of the specification.

Examiner is not persuaded. Claim 1 claims:

- (1) a set of documents for training
- (2) a first set of documents identified from the training set
- (3) a second set of documents identified from the training set
- (4) a remainder set of documents identified from the training set
- (5) a set of documents identified from the remainder set of documents

Examiner is not able to map above features 2-4 to Figures 12b-12c and thus feature 5, i.e., the remainder set of documents is also indefinite.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached Monday through Friday between 8:00 am and 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

8/29/2006



Primary Examiner